

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Patent Public Advisory Committee Quarterly Meeting

## Clarity of the Record Pilot

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# Purpose

This program is to develop **best Examiner practices** for enhancing the clarity of various aspects of the prosecution record and then to **study the impact** on the examination process of implementing these best practices.

# Goals

- Identify best practices
- Find the correct balance for appropriate recordation
- Use data/feedback to assist other programs, such as:
  - Refinement of the Master Review Form (MRF)
  - The reevaluation of examination time

# Areas of Focus

- Enhanced documentation of claim interpretation
  - Special definitions of claim terms
  - Optional language
  - Functional language
  - Intended use or result (preamble and body of claim)
  - Non-functional descriptive material
  - "Means-plus-function" (35 U.S.C. §112(f))
  - Computer-implemented functions that invoke 35 U.S.C. §112(f) ("specialized" or "non-specialized")
- More precise reasons for allowance
- More detailed interview summaries
- Pre-search interview – Examiner's option

# Pilot Participants

- Examiners
  - 125 participants (2/3 primary and 1/3 junior)
  - GS 11-15, with at least two years of experience
  - Randomly selected individuals, who met the requirements for participation, were invited to volunteer for the Pilot
- Supervisors (SPEs)
  - 45 participants

# Examiner Participant Duties

- Enhance clarity of Office actions for applications in the pilot
- Attend Pilot-specific training and quality enhancement meetings (QEMs)
- Record amount of time spent on Pilot activities

# Supervisor Participant Duties

- Manage Pilot-specific QEMs and group training
- Review Office actions using the Master Review Form (MRF)
- Provide individual feedback and assistance



# Evaluation

- Approximately 2,600 applications were reviewed:
  - Pilot Reviews (Examiners participating in the Pilot)
    - Pre-Pilot cases – office actions completed prior to Pilot start date
    - Pilot treated cases – actions completed using pilot guidelines/training
    - Pilot non-treated cases – actions not assigned/no requirement to follow Pilot guidelines
  - Control Group Reviews (Examiners closely matched with Pilot Examiners (e.g. same technology and GS Level))
- Examiner Best Practices were gathered during:
  - Initial Pilot Training
  - Pilot Specific Quality Enhancement Meetings (QEMs) with Examiners
    - QEMs were held at least monthly
  - Focus Sessions held with Pilot SPES

# Results and Recommendations – Interview Summaries

- Identified ***best practices*** (also key drivers) for improving the clarity of interview summaries included:
  - Adding the substance of the Examiner's position
  - Providing the details of an agreement, if reached
  - Including a description of the next steps that will follow the interview
- Recommendations:
  - Provide corps-wide training on enhancing the clarity of interview summaries that focuses on the identified best practices/key drivers
  - Consider whether to require examiners to complete more comprehensive interview summaries
  - Continue to evaluate Pilot cases to see whether improved interview summary clarity has a long-term impact on prosecution

# Results and Recommendations – 112(f) Limitations

- Identified ***best practices*** (also key drivers) for improving the clarity of 112(f) presumptions included:
  - Explaining 112(f) presumptions and how the presumptions were overcome (when applicable)
  - Using the appropriate form paragraphs
  - Identifying in the specification the structure that performs the function
- Recommendation:
  - Consider whether to require examiners to use the form paragraph which will result in a more comprehensive explanation of means-plus-function limitations

# Results and Recommendations – Claim Interpretation: Prior Art Rejections

- Identified ***best practices*** (also key drivers) for improving overall clarity of prior art rejections included:
  - Clearly addressing all limitations in 35 USC 102 rejections when claims were group together
  - Explaining the treatment of intended use and non-functional descriptive material limitations in 35 USC 103 rejections

# Results and Recommendations – Claim Interpretation: Prior Art Rejections (cont.)

- Some identified best practices both ***added to*** and ***deducted from*** overall clarity
  - Providing, in 35 USC 102 rejections, an explanation for limitations that have been identified as inherent
  - Providing, in 35 USC 103 rejections, annotations to pin-point where each claim limitation is met by the references
- Recommendation:
  - Assess how to use the identified best practice of recording claim interpretation to improve the clarity of Office actions *without* detracting from clarity

# Results and Recommendations – Reasons for Allowance

- Identified ***best practices*** for improving the clarity:
  - Identifying the allowable subject matter rather than merely reciting the entire claim
  - Specifying applicant's persuasive arguments
  - If reasons for allowance previously identified during prosecution, providing the Office action where reasons for allowance can be found
  - Addressing each independent claim separately
- Recommendations:
  - Provide corps-wide training on enhancing the clarity of reasons for allowance that focuses on the identified best practices/key drivers
  - Consider whether to require Examiners to complete more comprehensive reasons for allowance

# Results – Additional Practices that did not Significantly Impact Overall Clarity

- Providing an explanation regarding the patentable weight given to a preamble
- Providing an explanation of how relative terminology in a claim is being interpreted
- Providing an explanation for how a claim limitation that was subject to a rejection under 35 USC 112(b) has been interpreted for purposes of applying a prior art rejection

# Pilot Implementation - Hours

- Examiners were not limited on the amount of non-production time they could claim while working on Pilot-treated cases
- In total, examiners logged approximately 5400 hours on their Pilot cases
- On average, examiners used less than 4 hours per biweek of non-production time
- There was no difference in the number of hours claimed by primary examiners compared to junior examiners



# Pilot Implementation - Pre-Search Interviews

- No pre-search interviews were conducted during the Pilot
- Examiners attempted to conduct pre-search interviews, but could not readily identify an attorney of record to contact

# Next Steps

- Surveys
  - Internal surveys sent to Pilot Examiners
  - Data currently being collected
- Additional Quality Chats on Clarity
  - Gather information/thoughts on any differences seen during Pilot time period
  - Share data results of Pilot
  - Discuss/share best practices
- Focus Sessions with Pilot Examiners
  - Are best practices still being used?
  - Discuss amended cases resulting from Pilot

# Next Steps (Cont.)

- Monitor Pilot Treated Cases
  - Are applicant's arguments more focused?
  - Average time to disposal compared to pre-pilot cases?
- Recommendations for Implementation
  - Discuss implementation of training and best practices in all Technology Centers
  - Discuss further efforts to enhance claim interpretation including key drivers that didn't significantly impact clarity
  - Extend & Expand Pilot to gather additional data analysis

# Additional Information

<http://www.uspto.gov/patent/initiatives/clarity-record-pilot>

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## Clarity of the Record Pilot



The **Clarity of the Record Pilot**, which is one of the [evolving programs](#) of the [Enhanced Patent Quality Initiative \(EPQI\)](#), identifies best examiner practices for enhancing the clarity of various aspects of the prosecution record. In particular, the Pilot focuses on best practices regarding enhanced documentation of claim interpretation, more detailed interview summaries, and more precise reasons for allowance. The Pilot studies the impact of implementing such best practices during examination. The Pilot is underway, and is expected to end on August 20, 2016.

### Goals of the Pilot

- To identify and help develop best examiner practices for enhancing the clarity of the prosecution record so as to provide applicants with a deeper understanding of the Office's positions during prosecution.
- To obtain feedback on the correct balance for appropriate recordation of an examiner's determinations during examination.
- To assist with the development of the [Master Review Form](#).

### Pilot Participants and their Duties

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# Questions and Comments

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